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OFFICE OF PETITIONS

In re Application of
Kristopher T. Kohl and
C. Mitch Means
Application No. 09/658,907
Filed: September 11, 2000
Attorney Docket No. 194-13026-CI

: DECISION GRANTING PETITION
: UNDER §1.48(f)(1) and
: DECISION NOTING JOINDER OF
: INVENTOR AND PETITION
: UNDER 37 CFR 1.47(a) MOOT

This is in response to the request for correction of inventorship under 37 CFR 1.48(a), and the petition under 37 CFR 1.47(a), both filed May 14, 2001. This is also in response to the petition for admission of declaration and power of attorney filed June 11, 2001.

The above-identified application was filed on September 11, 2000, without an executed oath or declaration and identifying Kristopher T. Kohl as sole inventor. Accordingly, on November 14, 2000, a "Notice to File Missing Parts of Application," was mailed to applicant, requiring an executed oath or declaration and a surcharge for late filing under §1.16(e). This Notice set a two-month period for reply.

In reply, applicant filed the instant request under §1.48(a) to amend the inventorship to add a joint inventor, C. Mitch Means, and a petition (and fee) for status under §1.47 because of the unavailability of inventor Kohl to join in the application. The reply was made timely and complete by an accompanying request for a four-month extension of time and payment of the surcharge. Prior to the decision on petition filed May 14, 2001 refusing status under §1.47(a) being mailed, petitioner on June 11, 2001, filed a declaration and power of attorney executed by both inventors, Kohl and Means.

In regards to the request for correction of inventorship, applicant's attention is directed to 37 CFR 1.48(f)(1), which provides that:

If the correct inventor or inventors are not named on filing a nonprovisional application under §1.53(b) without an executed oath or declaration under §1.63 by any of the inventors, the first submission of an executed oath or declaration under §1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship.

Pursuant to this section, no petition is necessary in this case to correct inventorship. The first submission, on May 14, 2001, of a declaration executed by inventor Means on behalf of himself and on behalf of non-signing inventor Kohl serves to correct the

inventorship. However, a declaration signed by one inventor on behalf of another is only sufficient where applicant has established status under §1.47(a). On petition filed May 14, 2001, applicants did not establish such status because: 1) applicants did not demonstrate that a *bona fide attempt* was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d); and 2) the petition did not include a statement of non-signing inventor Kohl's last known address¹.

Nonetheless, the declaration filed June 11, 2001 has been reviewed and found in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered moot. This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this Office for further consideration under 37 CFR 1.47(a).

As the petition under 1.47(a) was considered on the merits, the petition fee is being retained.

The application file is being returned to the Office of Initial Patent Examination (OIPE) for completion of pre-examination processing, including adding C. Mitch Means as a joint inventor pursuant to the declaration and power of attorney filed June 11, 2001, and sending applicant a corrected filing receipt.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.